REMARKS

Claims 1-8 are pending in the application.

Rejections Under 35 U.S.C. § 102(e)

Claims 1-8 stand provisionally rejected under 35 U.S.C. § 102(e) as being anticipated by copending Application Nos. 10/690,955 and 10/690,751. The parent applications of which, U.S. Application Nos. 10/160,463 and 10/160,361 were filed May 31, 2002.

In a telephone interview with Examiner Moore dated April 7, 2005, Examiner Moore requested additional information to support Applicants' assertion of a date of invention prior to May 31, 2002. Specifically, the Examiner requested that

1) Applicants present information establishing that the compound XP7139 shown in the notebook pages submitted in connection with the inventor Declaration of February 16th, 2005 (submitted with the Supplemental Response after Final dated February 17th, 2005) was the same as "SFA1" referred to in the examples presented in the application);
2) Applicants provide evidence of entitlement to the full scope of R_1 as set forth in Formula 1 in Claim 1; and
3) Applicants provide evidence of entitlement to the full scope of the 40-80% limitation in claim 1 on the amount of the reactive silane compound.

Applicants submit herewith a third Declaration under 37 C.F.R. 1.131 of inventor Richard Roesler. Provided in connection with the third declaration are copies of additional notebook pages and product registry information for XP7139 which establish item 1) above, that XP7139 is the same as SFA1 shown in the examples in the application.

Applicants have also established items 2) and 3) above. Specifically, as shown in the third declaration at paragraph 8 regarding item 2), it was well known that N-substituted aminopropyl silanes would provide the desired properties such as lower viscosity in silane terminated polyurethane resins The commercially available

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N-substituted aminopropyl silanes were not previously used because the process of their production was too expensive. The assignee of the present invention has a proprietary method of producing N-substituted aminopropyl silanes that makes their use in the methods of the present invention economically practical. As explained in the declaration by inventor Roesler, and as would be understood by one skilled in the art, any N-substituted aminopropyl silane will work.

Similarly, the third declaration provides the inventors' reasoning for the expectation that a range of 40-80% monosilane would work in the compounds of the present invention, in response to item 3) above. It was known at the time the invention was reduced to practice that 60% monosilane content provided the desired properties, whereas 90% monosilane content did not. In the inventors' judgment, based on the properties provided by the other ratios, 80% monosilane content was also expected to work.

Applicants respectfully submit that prior inventorship of the full scope of Claim 1 has been more than established in accord with the holding in numerous cases. A rule 131 affiant is not required to show a reduction to practice of every embodiment of the invention, *in Re Hostettler*, 356 F. 2d 562, 148 USPQ 514 (CCPA 1966). And, an applicant is not prevented from obtaining a patent to an invention where a compound described in a reference would have been obvious to one of ordinary skill in the art in view of what the affiant proves was completed with respect to the invention prior to the effective date of the reference. *In Re Clarke*, 356 F. 2d 987, 148 USPQ 665 (CCPA 1966). See also *in Re Spiller,* 500 F. 2d 1170, 182 USPQ 614 (CCPA 1974) and *in Re Strykker*, 435 F.2d 1340, 168 USPQ 372 (CCPA 1971). In *in re Strykker* the applicant was not prevented from obtaining a patent even though 1) applicant could not establish corroboration for the weight limitation claimed and 2) the weight limitation did not literally read on the weight limitation shown in the reference. In the present situation, Applicants' range of 40-80% reactive monosilane is coextensive with the ranges shown in the copending applications. Applicants are not required to show reduction to practice of every possible embodiment embraced

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by this range. Thus, Applicants have met the requirements as set forth in case law and have established prior inventorship of the full breadth of Claim 1. Applicants respectfully request that that the rejection under 35 U.S.C. § 102(e) be withdrawn.

CONCLUSION

As all outstanding issues have been addressed, Applicants submit that Claims 1-8 are in condition for allowance; such action is respectfully requested at an early date.

Respectfully submitted,

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